Remarks

Claims 81-120 were pending. By way of this response, claims 95, 96, 99, 100, 113, 119, and 120 have been amended, claims 81-94, 101-112 and 117 have been cancelled without prejudice, and claims 121-129 have been added. Support for the amendments to the specification and the claims can be found in the application as originally filed, and no new matter has been added. Accordingly, claims 95-100, 113-116, and 118-129 are currently pending.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 88-94 have been rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 88-94 have been cancelled as set forth above. Therefore, this rejection is moot.

Rejection Under 35 U.S.C. § 102

Claims 81-86 and 106-112 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Tuse et al. (U.S. Patent No. 6,482,799). Claims 88-94 and 101-117 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Maloy (U.S. Patent No. 5,792,831).

Applicant does not concede with the remarks made by the Examiner. However, to advance the prosecution of the subject

application, claims 81-86, 88-94, 101-112, and 117 have been cancelled. Therefore, applicant submits that the rejections of these claims is moot.

Claim 113 has been amended to recite that the composition is an oil-containing emulsion or an oil-containing suspension. Applicant respectfully traverses the rejections as they relate to amended claims 113-116.

As acknowledged in the Office Action, claim 95 is not anticipated by Maloy. Amended claim 113 includes the subject matter of claim 95, for example, that the composition is an oil-containing emulsion. Further, Maloy does not disclose, teach, or suggest a composition in the form of an oil-containing suspension, as recited in claim 113.

In view of the above, applicant submits that the present claims, and claims 113-116 in particular, are not anticipated by Maloy under 35 U.S.C. § 102.

Rejections Under 35 U.S.C. § 103

Claim 87 has been rejected under 35 U.S.C. § 103 as being unpatentable over Tuse et al. in view of Maloy. Claim 111 has been rejected under 35 U.S.C. § 103 as being unpatentable over Tuse et al. in view of Ding et al. (U.S. Patent No. 5,474,979). Claims 88-94 and 101-117 have been rejected under 35 U.S.C. § 103 as being unpatentable over Maloy in view of Huth et al. (WO 96/25183). Claims 95-100 and 118-120 have been rejected under 35 U.S.C. § 103 as being unpatentable over Maloy in view of Huth et al. and further in view of Ding et al. Claim 107 has been

rejected under 35 U.S.C. § 103 as being unpatentable over Maloy in view of Huth et al, and further in view of Ripley et al. (U.S. Patent No. 5,736,165).

As indicated above, claims 81-94, 101-112, and 117 have been cancelled. Therefore, applicant submits the rejections of these claims are moot.

Applicant respectfully traverses the rejection of claims 95, 119, and 120 as they existed before, and after the present amendments. Amended claims 95, 119, and 120 indicate that the composition is an oil-containing emulsion or is an oil-containing suspension. Similarly, independent claim 113 also indicates that the composition is an oil-containing emulsion or an oil-containing suspension. Thus, all of the present claims are directed to compositions which are oil-containing emulsions or oil-containing suspensions. In other words, the present compositions include an oily substance.

None of the cited references, and Maloy, Huth et al, and Ding et al., in particular, disclose, teach or suggest the present invention, for example, as recited in claims 95, 119, and 120. Applicant submits that these claims are unobvious from and patentable over the prior art because the cited references provide no motivation or incentive to a person of ordinary skill in the art to combine their teachings for any purpose, let alone for the purpose of obtaining the claimed compositions and method. For example, applicant submits that there is no motivation to combine the references because the combination of references actually teach away from the claimed invention.

As the Examiner is aware, a reference must be interpreted as a whole, and cannot be picked apart to deprecate an invention (*In re Fine*, 837 F.2d 1071, 1075, (Fed. Cir. 1988)). "As a general rule, references that teach away cannot serve to create a prima facie case of obviousness." (*McGinley v. Franklin Sports, Inc.* CAFC 8/21/01 citing *In re Gurley*, 31 USPQ2d 1131, (Fed. Cir. 1994))

In the Office Action, the Examiner is relying on the disclosure of Ding et al. for the teaching of emulsions, and states that it would be obvious to combine the disclosure of Ding et al. with Maloy in view of Huth et al. to achieve the beneficial results taught by Ding et al.

Applicant respectfully disagrees, and submits that a person of ordinary skill in the art would not be motivated to combine the references, including Maloy in view of Huth et al. and Ding et al because the primary reference, Maloy, actually **teaches away** from the combination.

Maloy does not disclose, teach, or even suggest compositions that are oil-containing emulsions or oil-containing suspensions. For example, Maloy discloses that when the peptide is administered topically, the peptide is administered in a water-soluble vehicle. The water soluble vehicle is preferably free of an oily substance. (Column 38, lines 22-30). Thus, because Maloy actually teaches away from including an oily substance in the compositions, and thus, Maloy teaches away from oil-containing emulsions and oil-containing suspensions, applicant submits that a person of ordinary skill in the art would not be motivated to combine Maloy and Ding et al., with or

without Huth et al., to produce the compositions of claims 95, 119, and 120 which are defined as oil-containing emulsions or oil-containing suspensions.

In view of the above, applicant submits that the present claims, and claims 95-100, 113-116, and 118-129 in particular, are unobvious from and patentable over the combination of Maloy in view of Huth et al. and further in view of Ding et al. under 35 U.S.C. § 103.

In addition, each of the present dependent claims is separately patentable over the prior art. For example, none of the prior art disclose, teach, or even suggest the present compositions or methods including the additional feature or features recited in any of the present dependent claims. Therefore, applicant submits that each of the present claims is separately patentable over the prior art.

In conclusion, applicant has shown that the present claims satisfy the requirements of 35 U.S.C. § 112, and are not anticipated by and are unobvious from and patentable over the prior art under 35 U.S.C. §§ 102 and 103. Therefore, applicant submits that the present claims, that is claims 95-100, 113-116, and 118-129 are allowable. Therefore, applicant requests the Examiner to pass the above-identified application to issuance at an early date. Should any matters remain unresolved, the Examiner is requested to call (collect) applicant's attorney at the telephone number given below.

Date: May 26, 2004

Respectfully submitted,

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